No. 18-302

In The
Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

ERIK BRUNETTI,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF FOR RESPONDENT

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QUESTIONS PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. §1502(a), prohibits the registration of a trademark that "Consists of or comprises immoral . . . or scandalous matter. . . ." (Hereinafter referred to as the "Scandalous Clause.")

The Questions Presented are:

1. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment. *(This is identical to the Government's question presented.)*

2. Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is unconstitutionally vague under the First and Fifth Amendments. *(This is an additional question proposed by Brunetti.)*

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
TABLE OF AUTHORITIES	iv
STATEMENT	1
ARGUMENT	2
I. Certiorari Should Be Granted	2
II. The Court Should Decide How *Marks* Applies to the Plurality Opinions in *Tam*	3
III. The Scandalous Clause Is a Restriction on Speech	5
A. *Tam* Held that the Disparagement Clause Is a Restriction on Free Speech; the Scandalous Clause Is No Different	5
B. Use of a Scandalous Mark Could Be Totally Prohibited if the Scandalous Clause Were Constitutional	6
IV. The Scandalous Clause Is Viewpoint Regulation	7
A. The Scandalous Clause Cannot Be Reasonably Interpreted as Limited to Profanity, Excretory and Sexual References	7
B. All Profanity, Excretory or Sexual Refusals Are Based Upon Offensiveness	9
C. Profanity Expresses Viewpoint	11
D. All Scandalous Clause Refusals Are Based Upon Viewpoint	12

TABLE OF CONTENTS – Continued

Page

E. The Refusal in This Case Was Inextricably Intertwined With Brunetti's Core Speech Viewpoints 13

V. The Government Advances Arguments that Were Explicitly or Implicitly Rejected in *Tam* 14

A. Trademark Registration Is Not a Government Subsidy 14

B. Spending Clause 15

C. Time and Place/Limited Public Forum ... 15

D. Government Speech 16

E. Government Program 16

VI. The Scandalous Clause Is Unconstitutionally Vague 17

CONCLUSION 18

TABLE OF AUTHORITIES

Page

CASES:

Bad Frog Brewery v. New York State Liquor Authority, 134 F.3d 87 (2d Cir. 1998) 6

Bethel Sch. Dist. No. 403 v. Fraser, 478 U.S. 675 (1986) 15

Cohen v. California, 403 U.S. 15 (1971) 11, 12

Davenport v. Washington Ed. Assn., 551 U.S. 177 (2007) 16

FCC v. Pacifica Foundation, 438 U.S. 726 (1978) 11, 22

General Media Comm'ns, Inc. v. Cohen, 131 F.3d 273 (2d Cir. 1997), *cert. denied*, 524 U.S. 951 (1998). 15

Hughes v. United States, 138 S. Ct. 1765 (2018) 5

In re Brunetti, 877 F.3d 1330 (Fed. Cir. 2017) ....*passim*

In re Geller, 751 F.3d 1355 (Fed. Cir. 2014) 8

In re Hepperle, 175 U.S.P.Q. 512 (T.T.A.B. 1972) 8

In re Riverbank Canning Co., 95 F.2d 327, 37 U.S.P.Q. 268 (C.C.P.A. 1938) 8

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) 8

In re Wilcher Corp., 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996) 9

Kalman v. Cortes, 723 F.Supp.2d 766 (E.D. Pa. 2010) 6

Marks v. United States, 430 U.S. 188 (1977) 1, 3, 4, 5, 16

Matal v. Tam, 137 S. Ct. 1744 (2017) ..... *passim*

TABLE OF AUTHORITIES – Continued

Page

Perry v. McDonald, 280 F.3d 159 (2d Cir. 2001).....15

Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015).....7

Reno v. American Civil Liberties Union, 521 U.S. 844 (1997).....7

Sambo's Restaurants, Inc. v. City of Ann Arbor, 663 F.2d 686 (6th Cir. 1981).....6

Ysursa v. Pocatello Ed. Assn., 555 U.S. 353 (2009) 16

STATUTES:

Lanham Act, Section 2(a) (15 U.S.C. §§1052(a) (*et seq.*).....*passim*

MISCELLANEOUS:

Re, Richard M., *Beyond the* Marks *Rule*, 132 Harv. L. Rev. (forthcoming 2019) (*available at* https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3090620) 3

Thurmon, Mark A., *When the Court Divides: Reconsidering the Precedential Value of Supreme Court Plurality Decisions*, 42 Duke L.J. 419 (1992) 3

Williams, Ryan C., *Questioning* Marks*: Plurality Decisions and Precedential Constraint*, 69 Stan. L. Rev. 795 (2017).....3

Trademark Manual of Examining Procedure ("TMEP"), Section 1203.01 8

STATEMENT

The decision below is correct. The Court of Appeals correctly concluded that the Scandalous Clause discriminated on content and therefore is subject to strict scrutiny. The Clause fails to survive such scrutiny and therefore is facially unconstitutional. The Court of Appeals also correctly rejected the Government's defenses. Brunetti is entitled to register his mark.

Although the decision below is correct, Brunetti concedes that certiorari should be granted. Brunetti acknowledges that when the Government requests review of the invalidation of an act of Congress on constitutional grounds, such request should be given significant deference. Brunetti also agrees that the questions presented are of great importance to the Government, other trademark owners, the public, and to Brunetti.

In *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Disparagement Clause was held facially invalid by a unanimous Court. However, some issues, including the level of scrutiny and some of the government's defenses, were decided by a four-to-four plurality. It is unclear how *Marks v. United States*, 430 U.S. 188 (1977), applies in such a situation. If certiorari is granted, this Court can clarify how *Marks* is to be applied.

The questions are squarely presented, they are ripe for adjudication, and they cannot reasonably be postponed to some future case.

There is no substantial dispute about the background of this case, which is well described in the Court of Appeals' decision, so it is not repeated here.

ARGUMENT

Brunetti concedes that the Government's petition for certiorari should be granted. However, unless the Court affirms based on the first question presented, the Court should consider the second question proposed by Brunetti.

I. Certiorari Should Be Granted

First, this Court's jurisprudence shows that it often reviews cases invalidating acts of Congress on constitutional grounds if requested by the Government. Brunetti does not dispute that it is sound policy, consistent with the separation of powers, to give deference to the Executive Branch's decision about which acts of Congress should be defended, up to and including review by this Court.

Second, the Government is correct that this is an important case with immediate and irreversible consequences. If certiorari is denied, the Government must start issuing registrations for purportedly scandalous marks. Once that begins, it will be difficult to reverse.

Third, the extent to which "scandalous" speech is constitutionally protected impacts a broad swath of governmental and private activity.

Fourth, lower courts need guidance on the appropriate level of scrutiny and the merits of the government's other arguments. *Tam* does not unambiguously provide that guidance because of the four-to-four plurality. In deciding this case, the Court will not only answer what *Tam* decided, but in doing so, the Court can elucidate how the *Marks* analysis is to be performed. Providing guidance to lower courts on the application of *Marks* is an equally important reason for granting certiorari in this case.

II. The Court Should Decide How *Marks* Applies to the Plurality Opinions in *Tam*

If the Court grants review, the Court likely will address the extent to which *Tam* is a binding precedent. *Marks* provides guidance about elucidating holdings from plurality opinions. "When a fragmented Court decides a case and no single rationale explaining the result enjoys the assent of five Justices, the holding of the Court may be viewed as that position taken by those Members who concurred in the judgments on the narrowest grounds." *Marks*, 430 U.S. at 193. However, there are many unanswered questions about how *Marks* is to be applied in practice.[1]

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[1] *See, e.g.*, Re, Richard M., *Beyond the* Marks *Rule*, 132 Harv. L. Rev. (forthcoming 2019) (*available at* https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3090620); Williams, Ryan C., *Questioning* Marks*: Plurality Decisions and Precedential Constraint*, 69 Stan. L. Rev. 795 (2017); Thurmon, Mark A., *When the Court Divides: Reconsidering the Precedential Value of Supreme Court Plurality Decisions*, 42 Duke L.J. 419 (1992).

It is not necessary in this brief to advance detailed contentions about what holdings in *Tam* are properly deduced using a *Marks* analysis. But a few comments may be useful now. In *Tam*, there are a number of issues essential to the judgment, some of which were decided unanimously. Other issues were decided four-to-four. Is *Marks* to be applied issue-by-issue or some other way? Justice Kennedy's opinion did not decide the government's defenses, even though some were explicitly rejected by Justice Alito in his opinion. Are the preliminary issues or defenses decided by Justice Alito considered "narrowest" under *Marks*?

Justice Kennedy applied "heightened scrutiny," which he also referred to as "rigorous constitutional scrutiny." *Tam*, 137 S. Ct. at 1750, 1765 (Kennedy, J.). That is not *Central Hudson* "intermediate scrutiny." Nor, apparently, is it "strict scrutiny." Does Justice Thomas' concurrence, together with the four justices joining Justice Kennedy's opinion, make five for scrutiny greater than intermediate scrutiny? Can a level of scrutiny be a subset of another level (so one is "narrowest")? Or instead, do we look at the justices' reasoning (*i.e.*, in a Venn diagram, the circles of the justices' reasoning do not overlap). If the latter, was the level of scrutiny decided by an evenly divided court and therefore, without precedential effect, at least as to that issue? If *Tam* was not precedential on some issues, then the Court will need to decide such issues *de novo* in this case.

A bright line rule for applying *Marks* would be beneficial. A separate Question Presented on the applicability of *Marks* is not required since the Questions

Presented necessarily include whether *Tam* is a binding precedent under *Marks*.[2]

III. The Scandalous Clause Is a Restriction on Speech

A. *Tam* Held that the Disparagement Clause Is a Restriction on Free Speech; the Scandalous Clause Is No Different

The Government contends that the Scandalous Clause is simply a "lawful eligibility requirement for federal trademark registration." Petition at 18. It argues that the Court of Appeals "erred in treating [the Scandalous Clause] as an affirmative restriction on speech." Petition at 17. The Government concludes from that incorrect premise that the Scandalous Clause requires no constitutional scrutiny, or possibly only a rational basis analysis. Petition at 22 to 23. However, *Tam* recognized that federal trademark registration confers significant benefits. 137 S. Ct. at 1753, Part I-B. The opinions of both Justice Alito and Justice Kennedy in *Tam* recognized that refusal to register marks due to the Disparagement Clause is unconstitutional despite the fact that such marks could still be used. *See id.* at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). No principled reason exists for distinguishing the Disparagement Clause from the Scandalous Clause as

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[2] In *Hughes v. United States*, 138 S. Ct. 1765 (2018), the Court granted certiorari to consider the application of *Marks*, but the Court found it unnecessary to reach the *Marks* issue. *Id.* at 1772.

to whether the refusal to register is a constitutionally relevant restriction on speech.

B. Use of a Scandalous Mark Could Be Totally Prohibited if the Scandalous Clause Were Constitutional

The Government defends the Scandalous Clause on the grounds that it is not a complete prohibition of use. However, that ignores an important point. If the Scandalous Clause were constitutional, then what else could the Government lawfully prohibit? Certainly, it would follow that the Government could constitutionally refuse registration of copyright for scandalous works. State and local governments could effectively block unpopular organizations advancing controversial causes (*i.e.*, causes that are scandalous to at least a portion of the public) by refusing to grant building permits, charitable solicitation registrations, business licenses, or sales tax permits. This is no hypothetical concern. *See, e.g.*, *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981) (unconstitutional to require, as condition for grant of a building permit, that a restaurant change its name from SAMBO'S); *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998) (New York alcohol board's rejection of label with frog raising a middle finger is an unconstitutional restriction on commercial speech); *Kalman v. Cortes*, 723 F.Supp.2d 766 (E.D. Pa. 2010) (Pennsylvania's refusal to accept I CHOOSE HELL PRODUCTIONS, LLC as an entity name is

an unconstitutional viewpoint-based restriction on speech).

IV. The Scandalous Clause Is Viewpoint Regulation

A. The Scandalous Clause Cannot Be Reasonably Interpreted as Limited to Profanity, Excretory and Sexual References

Brunetti discusses the Government's proffered interpretation of the Scandalous Clause now, so the Government hopefully will address these arguments in its opening brief on the merits, if review is granted. In its Petition, the Government ignored these points.

The Government interprets the Scandalous Clause to be limited only to marks that contain profanity, excretory or sexual matter. Petition at 15. The Government contends that if so limited, the Clause is content-neutral. This is not true: the Scandalous Clause results in refusal of trademarks based upon viewpoint. Thus, the Clause is subject to strict scrutiny under *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227-2231 (2015), or heightened scrutiny under Justice Kennedy's opinion in *Tam* (if the latter is precedential).

This Court "may impose a limiting construction on a statute only if it is readily susceptible to such a construction." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 884 (1997) (citation and internal quotation marks omitted). However, this principle does not authorize a court to select an unreasonable

interpretation of a statute in order to avoid a constitutional question. Petition at 42a; *see also id.* at 885 ("This Court will not rewrite a . . . law to conform it to constitutional requirements.") (citation and internal quotation marks omitted). The Government asserts that "scandalous" and "immoral" can be interpreted as being limited to only profanity, excretory and sexual matter. Such interpretation would unreasonably ignore the language enacted by Congress.

No authorities support the Government's novel interpretation of the Scandalous Clause. The legislative history shows the Scandalous Clause was intended to apply more broadly: "[W]e would not want to have Abraham Lincoln gin"), quoted, *In re Tam*, 808 F.3d 1321, 1336 (Fed. Cir. 2015). *See, e.g.*, *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 U.S.P.Q. 268, 269 (C.C.P.A. 1938) (MADONNA for wine was scandalous). The Government's *Trademark Manual of Examining Procedure* ("TMEP"), Section 1203.01, interprets the Scandalous Clause to cover more than profanity, excretory or sexual content. In actual practice, the Patent & Trademark Office refuses marks under the Scandalous Clause for other reasons, including religion (KHORAN, S/N 77/072261); drugs (ACAPULCO GOLD on suntan lotion eventually allowed after determined not to refer to marijuana, *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1972)); current events (TALIBAN COOKIE COMPANY, S/N 85/074857); political (STOP THE ISLAMISATION OF AMERICA, S/N 77/940879; *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014) (held application properly refused)); puns (COFFEE NAZI, S/N

86/103763); and life-style (WIFE BEATER, Reg. No. 0836434). *See also*, examples listed in Appendix A to Brunetti's Brief below, Docket 70.[3]

Finally, if no examining guideline, decision or treatise suggested that the Scandalous Clause was limited to profanity, excretory and sexual references—at least prior to the re-argument of *Brunetti* in 2017—then such Clause does not give reasonable notice about what speech is affected and would be invalid due to vagueness.

B. All Profanity, Excretory or Sexual Refusals Are Based Upon Offensiveness

The Government claims it is just regulating content and not viewpoint because, it contends, it is only refusing to register profanity, excretory and sexual matter. However, that is not true, the Government refuses to register *some* profanity, excretory and sexual content, and allows *some*. The basis for deciding whether to allow registration is how offensive the profanity, excretory or sexual matter is. A mark is refused if "it would be considered offensive by a substantial portion of the public." TMEP §1203.01, quoting *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996).

In actual practice, the Government allows registration of some profanity, for example, "bitch," and

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[3] It is hard to imagine any mark that disparages an ethnic group would not also cause scandal, and therefore, should be refused under the Scandalous Clause, assuming it were constitutional. Yet, that would be plainly contrary to *Tam*.

"damn." The Government allows marks that use the word "fuck," provided it is misspelled or not spelled out (FCUK, Reg. No. 2920270; FWORD, S/N 75/590854; and WTF IS UP WITH MY LOVE LIFE?!, Reg. No. 4024774). As to excretory words, the Government allows "feces," "poop," "turd," (FAMOUS FECES, S/N 78/315509; POOP, Reg. No. 2956358; and TURD TOTER (BECAUSE NOBODY WANTS TO SEE YOUR TURD), Reg. No. 5397982), even though their meaning is identical to "shit," which the Government usually refuses. The Government also allows "piss" and "urine." (SATAN'S PISS, Reg. No. 5233724 and URINE OFF, Reg. No. 2553449). The Government allows some sexual terms, for example, "foreplay," "intercourse" (IRISH BY INTERCOURSE, Reg. No. 4136786), 69 (when referring to sexual activity as in MILE HIGH 69, S/N 87/718907 and LOOPY SEX GAME 18+ OH 69, Reg. No. 5583858) and PINK TACO (when referring to female genitalia, *e.g.*, PINK TACO FAN CLUB, S/N 77/402098, refused for other reasons).[4]

In short, the Scandalous Clause is not a content-neutral rule that rejects all profanity, excretory and sexual content. Instead, the Government is selectively approving or refusing profanity, excretory and sexual

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[4] The Government asserts that the Court of Appeals "erred in dismissing the government's legitimate justifications for denying the benefits of federal trademark registration to sexually explicit content." Petition at 22. Brunetti's mark is not obscene. The Government conflates scandalous with obscenity. Whether the Government can regulate obscenity is irrelevant to the facial invalidity of the Scandalous Clause as to purportedly scandalous marks.

content *based upon the level of perceived offensiveness*. *Tam* held unanimously that the Disparagement Clause was unconstitutional because it "offends a bedrock First Amendment principle: Speech may not be banned on the grounds that it expresses ideas that offend." *Tam*, 137 S. Ct. at 1750; *see also id.* at 1763 ("Giving offense is a viewpoint.") (Alito, J.).

C. Profanity Expresses Viewpoint

The Government argues that profanity does not express viewpoint, yet the Government continues to ignore the reasoning in *Cohen v. California*, 403 U.S. 15 (1971). Justice Harlan wrote:

> "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which, practically speaking, may often be the more important element of the overall message sought to be communicated." *Id.*, at 26.

No one who hears George Carlin's *Filthy Words* (often referred to as *Seven Words You Can Never Say on Television*), the subject of *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978), can doubt that profanity does

express viewpoint. The Court in *Pacifica* never questioned that Carlin's monologue was "'speech' within the meaning of the First Amendment," only whether time and place restrictions were appropriate. *Id.* at 744. Profanity does express viewpoint.[5]

D. All Scandalous Clause Refusals Are Based Upon Viewpoint

On an even broader level, Scandalous Clause refusals are always based upon the Government's opinion that the viewpoint expressed is offensive. Marks favorable to religion are allowed, but marks critical of religion or likely to cause religious controversy are prohibited. Marks that are cheerful and positive (*e.g.*, Smiley Face) are granted, while viewpoints that are negative or controversial (*e.g.*, middle finger-shaped bottle design) are refused. Marks about input into the digestive system are approved, while marks about

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[5] Justice Harlan wrote:

> "How is one to distinguish this ["fuck"] from any other offensive word? Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. Yet no readily ascertainable general principle exists for stopping short of that result were we to affirm the judgment below. For, while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen*, 403 U.S. at 26.

output are rejected. Polite humor is fine, raunchy humor is scandalous. Raising babies is sweet, making babies is disgusting. Kissing is fine, sex is dirty. Feminism is good, misogyny is bad. The word PENIS is allowed, an outline of a penis is not. Promotion of capitalism is okay, criticism of capitalism is scandalous (compare CORPORATE MASTURBATION, S/N 77/747036, denied, with MASTURBATION DIET, Reg. 5537456, granted). In all these situations, the Government is preferring certain viewpoints over other, disfavored viewpoints.

E. The Refusal in This Case Was Inextricably Intertwined With Brunetti's Core Speech Viewpoints

In this case, the Trademark Trial and Appeal Board (the "Board") affirmed the refusal of Brunetti's mark *because* of his viewpoint. The Board determined that Brunetti's FUCT mark was offensive because the Government concluded the mark meant "fucked." The Board found that Brunetti "objectifies women and offers degrading examples of extreme misogyny," "anti-social imagery," is "lacking in taste," and contains a theme "of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste." Petition at 63a to 64a. While the Board grossly mischaracterized Brunetti's viewpoints, Brunetti's perceived views were

inextricably intertwined with the Board's decision as to whether his mark is scandalous.

V. The Government Advances Arguments that Were Explicitly or Implicitly Rejected in *Tam*

In its Petition, the Government raises several arguments in defense of the Scandalous Clause. Some brief comments may be useful to the Court at this stage.

A. Trademark Registration Is Not a Government Subsidy

In *Tam*, Justice Alito unequivocally rejected the argument that federal trademark registration is a subsidy. 137 S. Ct. at 1761 (Alito, J.). Justice Alito's opinion could be considered the precedential opinion of the Court because he decided the government-subsidy issue before reaching the constitutional question. It is noted that, although Justice Kennedy did not decide this issue, there is nothing in his opinion to suggest that he disagreed with Justice Alito's analysis. *See id.* at 1767 (Kennedy, J.). So even if Justice Alito's opinion is not precedential on this issue, the Court should adopt his well-reasoned analysis. *See also* Petition at 16a to 22a.

B. Spending Clause

The Government claims, "Congress legitimately determined that a federal agency should not use government funds to issue certificates 'in the name of the United States of America' conferring statutory benefits for use of vulgar words. . . ." Petition at 18 to 19. This appears to be a spending clause argument. Although not explicitly rejected in *Tam*, such argument is inconsistent with the judgment in *Tam*. In any event, as the Court of Appeals succinctly noted: "Trademark registration does not implicate Congress' power to spend funds." *See* Petition at 19a. Its analysis is correct.

C. Time and Place/Limited Public Forum

It is not clear what the Government is urging when it cites time and place regulation cases: *Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675 (1986); *Perry v. McDonald*, 280 F.3d 159 (2d Cir. 2001); and *General Media Comm'ns, Inc. v. Cohen*, 131 F.3d 273 (2d Cir. 1997), *cert. denied*, 524 U.S. 951 (1998). Those cases are not applicable because trademark registration is refused for all times and places, for all goods and services, and for all channels of trade (for example, not just on military bases, on public buses or billboards). What a government allows on its own property is much different than a refusal of registration for all times and places.

Although the Government's petition is less than clear, it seems to argue that the trademark register is a limited public forum. In *Tam*, Justice Alito expressed

doubt on whether trademark registration implicated a limited government forum, Part III-C (137 S. Ct. at 1763), but he did not expressly reject that contention, instead holding that the Disparagement Clause was viewpoint regulation. The Court of Appeals' analysis of this point is correct. Petition at 22a to 28a.

D. Government Speech

The Government asserts, "the government's registration of a scandalous term as a trademark, which results in publication of that mark on the Principal Register and allows the registrant to use the mark with the ® symbol, would convey to the public that the United States regards scandalous images and terms as appropriate source identifiers in commerce." Petition at 24 to 25. Yet the government speech contention was rejected by all eight justices in Part III-A of Justice Alito's opinion in *Tam*. Private speech cannot be converted into government speech "by simply affixing a government seal of approval." *Tam*, 137 S. Ct. at 1758.

E. Government Program

The Government cites *Davenport v. Washington Ed. Assn.*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Ed. Assn.*, 555 U.S. 353 (2009). Part III-C of Justice Alito's opinion in *Tam* correctly distinguished those cases. *Tam*, 137 S. Ct. at 1762. If that portion of his opinion is not precedential under *Marks*, it is well-reasoned and should be persuasive in this case.

VI. The Scandalous Clause Is Unconstitutionally Vague

The Scandalous Clause is unconstitutionally vague. *Tam*'s footnote 5 (in Part II, decided seven-to-one) suggests the Court was concerned about the Disparagement Clause's vagueness, but the Court did not reach that issue. The Scandalous Clause does not give fair notice of what marks are or are not prohibited. This is confirmed by the Government's inconsistent and contradictory decisions on trademark applications. *See* Appendix A to Brunetti's Brief below, Docket 70. The Scandalous Clause grants excessive discretion to government officials.[6] The PTO's use and misuse of evidence, and the lack of an objective standard, exacerbates this concern.[7] The Government should also grant certiorari on this Question Presented.

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[6] In this case, Brunetti's application *was approved* for publication by the examining attorney assigned to the application. It was only after the application was approved for publication that the Government exercised the extraordinarily unusual step of withdrawing the application from publication.

[7] Applications are refused based upon dubious evidence (for example, in this case, the *Urban Dictionary*, which is "written" by anonymous postings, Petition at 6a to 7a). The PTO assumes that some, never-articulated, percentage of the population, will think the mark is offensive. The PTO never obtains opinion survey (in contrast to other areas of trademark practice). The PTO disregards actual evidence that a mark as used in the marketplace is not offensive. Petition at 62a to 63a.

CONCLUSION

Brunetti does not dispute that review by this Court is appropriate. The Court should grant certiorari, and affirm the Court of Appeals. In so doing, the Court can establish an unambiguous bright-line test for the precedential effect of plurality opinions.

Respectfully submitted,

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